



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,702	10/06/1999	DOMINIQUE CAZIN	511/96506.01	6300

7590 12/18/2002

EUGENE C. RZUCIDLO ESQ  
GREENBERG TRAURIG LLP  
885 THIRD AVENUE  
21ST FLOOR  
NEW YORK, NY 10022

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/402,702

Applicant(s)

CAZIN, DOMINIQUE

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This communication is responsive to response filed on October 09, 2002.

#### ***Response to Applicant's Remarks***

1. Applicant's arguments filed on October 09, 2002 have been fully considered. A new rejection of claims 1-7 is as followed.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (US Patent No. 6,005,677).

Art Unit: 2622

Concerning claim 1, Suzuki discloses a facsimile machine (FA1, FA2, Fig.1) designed to be connected to a telephone network (GSTN) and to communicate with corresponding facsimile machines (FA2, FN1, ..., FNn) across a computer network of the Internet type (LAN#1, LAN#2, Internet), the fax machines (FA1, FA2), each having an electronic address on the aforesaid computer network, characterized by the fact that it has memory means (3, Fig.2; Fig.3) for storing a record of the fax machine, containing the electronic addresses of the aforesaid corresponding fax machines, means for managing the record (1), for extracting the electronic addresses and associating them with the corresponding fax machines, and means for extracting a corresponding fax machine for its electronic address, the managing means 1 enters the electronic address of the corresponding fax machine into the table (Figs. 1-3, 8; Abstract; col. 2, line 41 – col. 5, line 13; col. 5, line 32–59; col. 6, line 22 - col. 8, line 52).

Concerning claims 2-7, Suzuki further teaches the facsimile machine (FA2, Fig.1) for receiving a fax transmitted from a corresponding fax machine (FA1) across the aforesaid and associated with the electronic address on the computer network, means (1) for managing the record stored in memory 3; means (12) is provided to send to a corresponding fax machine (FA2) via the computer network (INET) a fax associated with the electronic address on the computer network of the corresponding fax machine (FA2); means (1) are organized to extract the identification data from each address of a corresponding fax machine and to associate the data with the address in the record; means (1) compares the identification data extracted from each new electronic address relating to a corresponding fax machine with the identification data associated with the electronic addresses stored in the record; means (1) generates new address or

Art Unit: 2622

number, replaces or updates the record (Figs. 4-5, 9-11; col. 4, line 13 – col. 6, line 8; col. 7, line 14 – col. 10, line 26).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Toyoda et al (US Patent No. 6,259,533) discloses a facsimile apparatus for transmitting facsimile data as an electronic mail and electronic mail transmitting method.

b. Creamer (US Patent No. 6,028,917) teaches an access to extended telephone service via Internet.

c. Okada et al (US Patent No. 6,088,125) recites a facsimile machine and communication result notifying method.

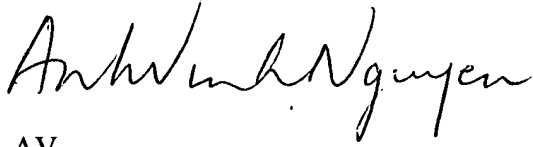
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

Application/Control Number: 09/402,702  
Art Unit: 2622

Page 5

A handwritten signature in black ink, appearing to read "Anh Vinh Nguyen". The signature is fluid and cursive, with the first name "Anh" and last name "Nguyen" being more prominent.

AV  
December 10, 2002

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622